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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/386,000
Filing Date: August 30, 1999
Appellant(s): MIYAZAKI, KENICHI

Billy Carter Raulerson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 22, 2005 appealing from the Office action mailed January 24, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

938,885	McCULLEY	11-1909
1,128,730	SMEDAL	02-1915
2,904,332	METZNER	09-1959
5,838,354	YAMADA et al.	11-1998
2,300,276	HAGEMAN	10-1942
EP0727375	ORBONS (EPO)	08-1996
JP 63-154558	TAKUMI (JPO)	06-1988
IP-4000 BROCHURE	SEIKO	06-1997
MicroStation Manager p.1-7 as posted at http://archive.msmonline.com/1997/12/products.html offering the OCE 9400 device for sale		12-1997
http://www.digital-es.com/o9400.htm showing specifications of OCE 9400 device		07-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 13, 16, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite a sheet feeding area positioned at a height at which a user who is approximately 170 cm tall, standing in front of the printer, does not have bend substantially at the waist when setting up the printing area. What is this height? Is the applicant claiming a person? What does the claim cover, if anything, if the user is 160 cm tall? What if the user is sitting, or kneeling? Is the applicant claiming the actions of a human being in

a apparatus claim? One of ordinary skill in the art would not be able to determine if he/she were infringing the claims.

As understood, claims 1, 5, 6, 16, 26, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamadà et al. Yamada discloses an image forming apparatus that includes at least one roll of paper (102) and one sheet of carton (101), a printing unit (2), a discharged paper stacking unit (301) below the printing unit and in a straight line via a paper path from the feeding unit through the printing unit, an elongative member (104a) and a pair of support members (l04b).

As understood, claims 13, 18, 26, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Orbons et al. (EP 0727375 A1).

As understood, claims 13, 17, 18, 26, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the IP-4000 device.

As understood, claims 1, 3, 5, 6, 13, 17, 18, 26, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the OCE 9400 device.

As understood, claims 16, 26, and 31are rejected under 35 U.S.C. 102(b) as being anticipated by Takumi (JP 63154558). Takumi discloses a sheet feeding area with an elongative member and a pair of supports pivotable toward the front of the printer.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Orbons (EP 07273754 A1). Yamada discloses all the limitations of the claim, but it does not disclose that the paper rolls are arranged obliquely to one another. However, Orbons discloses a sheet feeding unit that includes a plurality of paper rolls are arranged obliquely to one another for the purpose of simplifying roll replacement. It would have been obvious to a person

of ordinary skill in the art at the time of the applicant's invention to modify Yamada by having the paper rolls are arranged obliquely to one another, as disclosed by Orbons, for the purpose of simplifying roll replacement.

Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCulley in view of Smedal. McCulley discloses a paper roll attachment for a type writer that includes a sheet feeding area and a plurality of paper rolls arranged obliquely to each other, a printer (D), and a paper discharge area (generally at 19). McCulley discloses all the limitations of the claims, but it does not disclose a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, when the printer is placed substantially at ground level. However, Smedal discloses a roll attachment for type writers that includes a frame (5) with a vertical leg (3) adapted to be supported at any elevation (see page 1, lines 85-90), including a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, when the printer is placed substantially at ground level, for the purpose of adapting the attachment to any type writing machine (see page 1, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify McCulley by utilizing a frame with a vertical leg adapted to be supported at any elevation, including a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, when the printer is placed

substantially at ground level, for the purpose of adapting the attachment to any type writing machine.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hageman in view of Metzner. Hageman discloses a sheet feeding area which includes a roll of paper (46), a sheet of paper (s), and cover members (45/42). Hageman does not disclose that a single cover member extends linearly from an upstream portion to a downstream portion in which the sheet of paper is fed and the cover member is disposed between the sheet of paper and the roll of paper at a location in the sheet feeding area at which the roll of paper is in a rolled shape. Rather Hageman discloses two separate cover members (45, 42). Cover members (42) have a portion that extends linearly (42) that covers a first feeding path for the roll of paper from above and supports the sheet of paper from below. Additionally, cover members (45) have a portion between the sheet of paper (s) and the roll of paper (46) at a location in the sheet feeding area at which the roll of paper is in a rolled shape. However, Metzner discloses a single cover member (23) that extends linearly from an upstream portion to a downstream portion in which a sheet of paper is fed and the cover member is disposed between a sheet of paper and a feed pack at a location in the feed pack area for the purpose of continuously supporting the paper from the pack to the printing area. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Hageman by utilizing a single cover member that extends linearly from an upstream portion to a downstream portion in which a sheet of paper is fed and the cover member is disposed between a sheet of paper and a feed pack at a location in the feed pack area for the purpose of continuously supporting the paper from the roll to the printing area.

CLAIM CHARTS OF THE INDEPENDENT CLAIMS

CLAIM 1

Claim element	Yamada	OCE
A Large Printer comprising:	See Fig. 1	Device Height = 44"
a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton	col. 5, ln. 35-55 device not incapable of feeding one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton	The device has roll feed paper bypass and feeds thick originals (stiff carton)
the paper feeding unit being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process including replacement of the roll paper and setting at least one of the sheet of paper and the stiff carton	See Fig. 1	Device Height = 111 cm See Figure
a printing unit located below the paper feeding unit	item 2	See Fig. p. 4 of Microstation Magazine printout
a discharged paper stacking unit located below the printing unit; and	item 301	See Fig. p. 4 of Microstation Magazine printout
a paper feeding path extending in a substantially straight line from the paper feeding unit to the discharged paper stacking unit via the printing unit	See Fig. 1	See Fig. p. 4 of Microstation Magazine printout

CLAIM 3

Claim element	OCE
A Large Printer comprising:	Device Height = 44"
a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton	The device has roll feed, paper feed bypass and feeds thick originals (stiff carton)
the paper feeding unit being located at a height that enables a user standing in front of the printer to execute the paper feeding process including replacement of the roll paper and setting at least one of the sheet of paper and the stiff carton	Device Height = 111 cm See Figure
a printing unit located below the paper feeding unit	See Fig. p. 4 of Microstation Magazine printout
a discharged paper stacking unit located below the printing unit; and	See Fig. p. 4 of Microstation Magazine printout
a paper feeding path extending in a substantially straight line from the paper feeding unit to the discharged paper stacking unit via the printing unit,	See Fig. p. 4 of Microstation Magazine printout
wherein the paper feeding unit includes a cover member for covering the roll of paper from above and for supporting the supplied stiff carton from therebelow.	See Fig. p. 4 of Microstation Magazine printout (note intended use recitation)

CLAIM 13

Claim Element	IP-4000	Orbons
A large printer comprising:	See Brochure Cover	See Fig. 1
a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level.	See p. 7 of translation device height = 116 cm feed rolls at top	See Fig. 1

CLAIM 16

Claim Element	Yamada	Takumi
A large printer comprising:	See Fig. 1	See P. 2
A sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist, wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level, the large printer further comprising:	See Fig. 1	See Fig. 1
an elongative member disposed in the paper feeding area for holding the medium, and	item 104 a (see Fig. 4)	See item 5
a pair of support members for supporting both ends of the elongative member,	item 104 b (see Fig. 4)	See item 5
at least one of the support members being pivotable toward the front of the printer.	item 104 b is capable of pivoting Toward the front of the printer	See Fig. 1

CLAIM 18

Claim Element	Orbons	IP 4000	OCE
A large printer comprising:	See Fig. 1	See Brochure Cover	Height= 111 cm
A sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist, wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level,	See Fig. 1	Device Height = 116 cm	Height= 111 cm
a printing area	item 3	See Title	See P. 4 Mag. printout
a paper discharge area; and	item 10	See Figures	See P. 4 Mag. printout
a paper feeding path which extends in a vertical direction from the paper feeding area to the paper discharge area via the printing area	See Fig. 1	See Figures	See Figure and P.4 Microstation Magazine printout

CLAIM 26

Claim Element	IP-4000	Yamada	Orbons	OCE	Takumi
A large printer comprising:	See Cover	See Fig.1	See Fig. 1	See Fig	See Fig. 1
A sheet feeding area operable to feed a plurality of rolls ranging in width from 210mm to 1120mm, a substantially flat sheet of paper ranging in length from 420mm to 1580mm and at least one stiff carton ranging in length from 420mm to 730mm	See p.6 specs.	See Fig.1 col. 5, ln. 35-55	col. 3 ln 1-11	See Specs.	See Fig. 1

CLAIM 17 (Rejected under 35 USC § 103)

Claim Element	Structure
A large Printer Comprising	McCulley Fig. 1
A sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level,	Smedal item 2 and 3
a printing area	McCulley item D
a paper discharge area; and	McCulley item 19
a paper feeding path extending from the paper feeding area to the paper discharge area via the printing area	McCulley Fig. 1
wherein the paper feeding area is located in an upper rear portion of the printer and the paper discharge area is located in a lower front portion of the printer	McCulley Fig. 1

CLAIM 15 (Rejected Under 35 USC § 103)

Claim Element	Structure
A large Printer Comprising:	Hageman Fig. 1
a sheet feeding area operable to feed at least one roll of paper, at least one sheet of paper and at least one stiff carton	Hageman items 46/S
toward a printing unit at which printing is performed thereon; and	Hageman item 10
a cover member, which covers a first feeding path for the roll of paper from above, and which supports at least one of the sheet of paper and the stiff carton from below to constitute a part of a second feeding path for the sheet of paper	Hageman items 45/42
wherein the cover member extends linearly from an upstream portion thereof to a downstream portion thereof in connection with a direction in which at least one of the sheet of paper and the stiff carton is fed at the sheet feeding area, and	Metzner item 23
wherein the cover member is disposed between at least one of the sheet of paper and the stiff carton and the roll of paper at a location in the sheet feeding area at which the roll of paper is in a rolled shape.	Hageman item 45

(10) Response to Argument

Rejections under 35 USC § 112 2nd Paragraph

The appellant states that claims 1-6, 13, and 16-18 are definite because the "user" in the claims is recited to provide a point of reference for ascertaining the height of the paper feeding unit of the large printer. The examiner's position is that the claims are indefinite. Even after being invited by the examiner to clearly define the height or range of heights, the appellant has consistently declined to provide an example of a height that reads on the claims. The examiner is not convinced that the appellant is capable of providing such a height. How is one of ordinary skill in the art supposed to determine the height if the appellant cannot provide an example of a height that reads on the claims? How can one of ordinary skill in the art ascertain the height of the paper feeding unit using a "point of reference when the "point of reference" itself is not ascertainable?

The claims do not clearly define a height. Claims 1 and 4 state, " . . . the paper feeding unit being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process . . .". Claims 13, 14, 16, and 18 state, " . . . a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level . . .". Claim 3 states, " . . . the paper feeding unit being located at a height that enables a user standing in front of the printer to execute the paper feeding process . . .". If there is no "user" (the device remains unused in an office or is being offered for sale), how does one of ordinary skill in the art know if he or she is infringing the claim? If the manufacturer and/or purchaser of a similar device have

no "users" who are approximately 170 cm tall, how will they determine if they are infringing the claim? Can a manufacturer and/or purchaser has users who are 170 cm tall but who are also confined to wheelchairs infringe the claim? If a manufacturer sells the same device to two different customers, both having a user approximately 170 cm tall but one customer's user having extremely short arms as the result of an accident or birth defect such that he or she must squat or sit down to execute the paper feeding process, does one customer infringe the claim while the other customer does not infringe the claim using the same device? The appellant states that he is free to be his own lexicographer. The examiner agrees, however, one of ordinary skill in the art must still be able to understand what the lexicography means. The claims are indefinite.

Rejections Under 35 USC § 102

Yamada

The appellant states that claims 1, 26, and 31 are not anticipated by Yamada because Yamada does not disclose a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton, as recited in the claims. The examiner disagrees.

This element of the claim does not limit the appellant's claims. The material or article worked on does not limit an apparatus claim. See MPEP § 2115. The claims are directed to an apparatus. The terms "roll of paper", "sheet of paper", and "stiff carton" are different articles the apparatus may work on. They impart no structural limitations to the claim. (What is the structural difference between a device that is operable to feed a stiff carton and a device that is operable to feed a flexible carton?) Therefore, Yamada anticipates the claims.

However, Yamada anticipates the claims even if the element limits the apparatus. As stated in the specification and affirmed by the appellant in the appellant's remarks on pages 3-4 of the appellant's paper dated May 10, 2004,the examiner notes that the claims do not require three different types of paper fed simultaneously, or three different types of paper. As stated by the appellant on page 4 of the appellant's remarks filed May 10, 2004, written to overcome a rejection under 35 USC 112 1st paragraph, "Thus, as clearly set forth herein, a stiff carton is characterized as an example of a sheet of paper." Based on the appellant's reasoning, the claim does not require three elements (a roll, a sheet of paper, and a stiff sheet of carton). Rather, the claim merely requires one element, paper, in three different states (flat, rolled, stiff).

Yamada discloses "a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton" as recited in the claims. Yamada discloses one element, paper, in three different states (flat, rolled, stiff). All paper has a degree of stiffness (or flexibility, i.e., lack of stiffness). Yamada illustrates rolls of paper (101, 102, 103). When the paper is fed off the roll, it becomes substantially flat. Finally, Yamada states that the rolls of paper (101, 102, 103) are formed by winding a substantially flat sheet of a predetermined size into a roll (see col. 5, lines 45-50). Therefore, Yamada discloses "a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton".

Alternatively, since Yamada is capable of operating to feed at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton, Yamada discloses "a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton" as recited in the claims. The claims do not require at least

one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton. ***The claims merely require that the paper feeding unit is capable of feeding*** one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton. Yamada does not disclose anything that would render it incapable of operating to feed at least one roll of paper, at least one substantially flat sheet of paper, and at least one stiff carton. Therefore Yamada anticipates the claim.

The appellant states that Yamada does not disclose "a paper feeding unit . . . located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process", as required by claim 1 or "a sheet feeding area positioned at a height at a which a user, who is approximately 170 cm tall, standing in front of the printer can set up a printing medium without having to bend substantially at the waist", as required by claim 16. Although the examiner does not know what these elements mean, the examiner disagrees. Yamada does not disclose anything that would prevent enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process or set up a printing medium without having to bend substantially at the waist. Therefore, Yamada anticipates the claims.

The appellant states that Yamada does not disclose "a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm" as required by claim 26. The examiner disagrees.

This element of the claim does not limit the appellant's claims. The material or article worked on does not limit an apparatus claim. See MPEP § 2115. The claims are directed to an

apparatus. The terms "paper rolls", "sheet of paper", and "stiff carton" are different articles the apparatus may work on. They impart no structural limitations to the claim. (What is the structural difference between a device that is operable to feed a sheet of paper that is 450 mm long and a device that is operable to feed a sheet of paper that is 400 mm long?) Therefore, Yamada anticipates the claims.

However, Yamada anticipates the claims even if the element limits the apparatus. As noted above, on page 4 of the appellant's remarks filed May 10, 2004, written to overcome a rejection under 35 USC 112 1st paragraph, the appellant stated, "Thus, as clearly set forth herein, a stiff carton is characterized as an example of a sheet of paper." Based on the appellant's reasoning, the claim does not require three elements (a roll, a sheet of paper, and a stiff sheet of carton). Rather, the claim merely requires one element, paper, in three different states (flat, rolled, stiff). All paper has a degree of stiffness (or flexibility, i.e., lack of stiffness), Yamada discloses the rolls, and, before the paper is rolled up and after the paper is fed off the roll, the paper is flat and could be any length. Yamada discloses a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm from at least two areas (101, 102....see col. 5, lines 45-50).

Alternatively, as noted above, ***the claims merely require that the paper feeding unit is capable of feeding*** the paper. Yamada does not disclose anything that would render it incapable of feeding a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm. Therefore, Yamada anticipates the claim.

Orbons

The appellant states that Orbons does not disclose a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level as required by claims 13 and 18. Although the examiner does not know what these elements mean, the examiner disagrees. Orbons does not disclose anything that would prevent which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. Therefore, Orbons anticipates the claims.

The appellant states that Orbons does not disclose "a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm" as required by claim 26. The examiner disagrees.

This element of the claim does not limit the appellant's claims. The material or article worked on does not limit an apparatus claim. See MPEP § 2115. The claims are directed to an apparatus. The terms "paper rolls", "sheet of paper", and "stiff carton" are different articles the apparatus may work on. They impart no structural limitations to the claim. (What is the structural difference between a device that is operable to feed a sheet of paper that is 450 mm long and a device that is operable to feed a sheet of paper that is 400 mm long?) Therefore, Orbons anticipates the claims.

However, Orbons anticipates the claims even if the element limits the apparatus. As noted above, on page 4 of the appellant's remarks filed May 10, 2004, written to overcome a rejection under 35 USC 112 1st paragraph, the appellant stated, "Thus, as clearly set forth herein, a stiff carton is characterized as an example of a sheet of paper." Based on the appellant's reasoning, the claim does not require three elements (a roll, a sheet of paper, and a stiff sheet of carton). Rather, the claim merely requires one element, paper, in three different states (flat, rolled, stiff). All paper has a degree of stiffness (or flexibility, i.e., lack of stiffness). Orbons discloses a sheet feeding area operable to feed a plurality of paper rolls (16, 17, 18, 19) ranging in width from 210 mm to 1120 mm (see col. 3, lines 1-12). The rolls are cut into A0, A1, A2, or A3 format (see col. 3, lines 1-12). A0 format sheets are 841 mm long, A1 format sheets are 594 mm long, A2 format sheets are 420 mm long, and A3 format sheets are 297 mm long. Orbons anticipates the claims.

Alternatively, as noted above, ***the claims merely require that the paper feeding unit is capable of feeding*** the paper. Orbons does not disclose anything that would render it incapable of feeding a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm. Therefore, Orbons anticipates the claims.

IP-4000 Device

The appellant states that the IP-4000 device does not disclose a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level as required by claims 13 and 18.

Although the examiner does not know what these elements mean, the examiner disagrees. The IP-4000 device is 116 cm high (see translation p. 7) with the sheet feeding area at the top of the device (see cover of brochure). The brochure of the IP-4000 device does not disclose anything that would prevent which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. Therefore, the IP-4000 device anticipates the claims.

The appellant states that the IP-4000 device does not have a paper feeding area in an upper rear portion of the printer and a discharge area in a lower front portion of the printer. The examiner disagrees. The brochure of the IP-4000 device discloses a front paper roll and a rear paper roll located at the top of the device and a paper discharge area at the bottom of the the device (see p. 2 of brochure, the top figure showing the paper coming out of the printer into the discharge area and the small figure on the left showing a front roll and two rear rolls). Paper coming off of a back rear roll, at the top of the device, is fed through the printer and discharged under the printer in the front of the device. The IP-4000 device has a paper feeding area in an upper rear portion of the printer and a discharge area in a lower front portion of the printer. The IP-4000 device anticipates the claims.

The appellant states that the IP-4000 device does not disclose "a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm" as required by claims 26 and 31. The examiner disagrees.

This element of the claim does not limit the appellant's claims. The material or article worked on does not limit an apparatus claim. See MPEP § 2115. The claims are directed to an apparatus. The terms "paper rolls", "sheet of paper", and "stiff carton" are different articles the apparatus may work on. They impart no structural limitations to the claim. (What is the structural difference between a device that is operable to feed a sheet of paper that is 450 mm long and a device that is operable to feed a sheet of paper that is 400 mm long?) Therefore, the IP-4000 device anticipates the claims.

However, the IP-000 device anticipates the claims even if the element limits the apparatus. As noted above, on page 4 of the appellant's remarks filed May 10, 2004, written to overcome a rejection under 35 USC 112 1st paragraph, the appellant stated, "Thus, as clearly set forth herein, a stiff carton is characterized as an example of a sheet of paper." Based on the appellant's reasoning, the claim does not require three elements (a roll, a sheet of paper, and a stiff sheet of carton). Rather, the claim merely requires one element, paper, in three different states (flat, rolled, stiff). All paper has a degree of stiffness (or flexibility, i.e., lack of stiffness). The IP-4000 discloses a sheet feeding area operable to feed substantially flat sheets of paper from a plurality of paper rolls (see p. 2 of brochure, the small figure on the left showing a front roll and two rear rolls) each one roll of A0, A1, and A3 (see translation page 6). A0, A1, and A3 represent standard sizes of paper. A0 paper is 841 mm wide and 1,189 mm long. A1 paper is 594 mm wide and 841 mm long. A3 paper is 297 mm wide and 420 mm long. Therefore the IP-4000 device discloses a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm.

Alternatively, as noted above, ***the claims merely require that the paper feeding unit is capable of feeding*** the paper. The IP-4000 device does not disclose anything that would render it incapable of feeding a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm. Therefore, the IP-4000 device anticipates the claims.

The OCE 9400 device

The appellant states that the examiner provides no rationale for stating that claims 1, 3, 5-6, 13, 17-18, 26, and 31 are anticipated by the OCE 9400 device. In response, the examiner notes that the rejection complies with 37 CFR § 1.104(c)(2). Claims 1, 3, 5-6, 13, 17-18, 26, and 31 are anticipated by the OCE 9400 device.

Takumi

The appellant states that Takumi does not disclose a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, standing in front of the printer can set up a printing medium without having to bend substantially at the waist. Although the examiner does not know what this element means, the examiner disagrees. Takumi does not disclose anything that would prevent which a user, who is approximately 170 cm tall, standing in front of the printer from setting up a printing medium without having to bend substantially at the waist. Therefore, Takumi anticipates the claim.

The appellant states that Takumi does not disclose "a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of

paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm" as required by claims 26 and 31. The examiner disagrees.

This element of the claim does not limit the appellant's claims. The material or article worked on does not limit an apparatus claim. See MPEP § 2115. The claims are directed to an apparatus. The terms "paper rolls", "sheet of paper", and "stiff carton" are different articles the apparatus may work on. They impart no structural limitations to the claim. (What is the structural difference between a device that is operable to feed a sheet of paper that is 450 mm long and a device that is operable to feed a sheet of paper that is 400 mm long?) Therefore, Takumi anticipates the claims.

Alternatively, as noted above, ***the claims merely require that the paper feeding unit is capable of feeding*** the paper. Takumi does not disclose anything that would render it incapable of feeding a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm. Therefore, Takumi anticipates the claims.

Rejections Under 35 USC § 103

Yamada in view of Orbons

The appellant states that, since claim 1 is not anticipated by Yamada and Orbons fails to make up for the deficiencies, claim 2 is patentable over the proposed combination. In response, the examiner refers to the discussion of the rejection of claim 1 by Yamada above.

McCulley in view of Smedal

The appellant states that the rejection under 35 USC § 103 is improper because both McCulley and Smedal are concerned with typewriters which are non-analogous art as compared

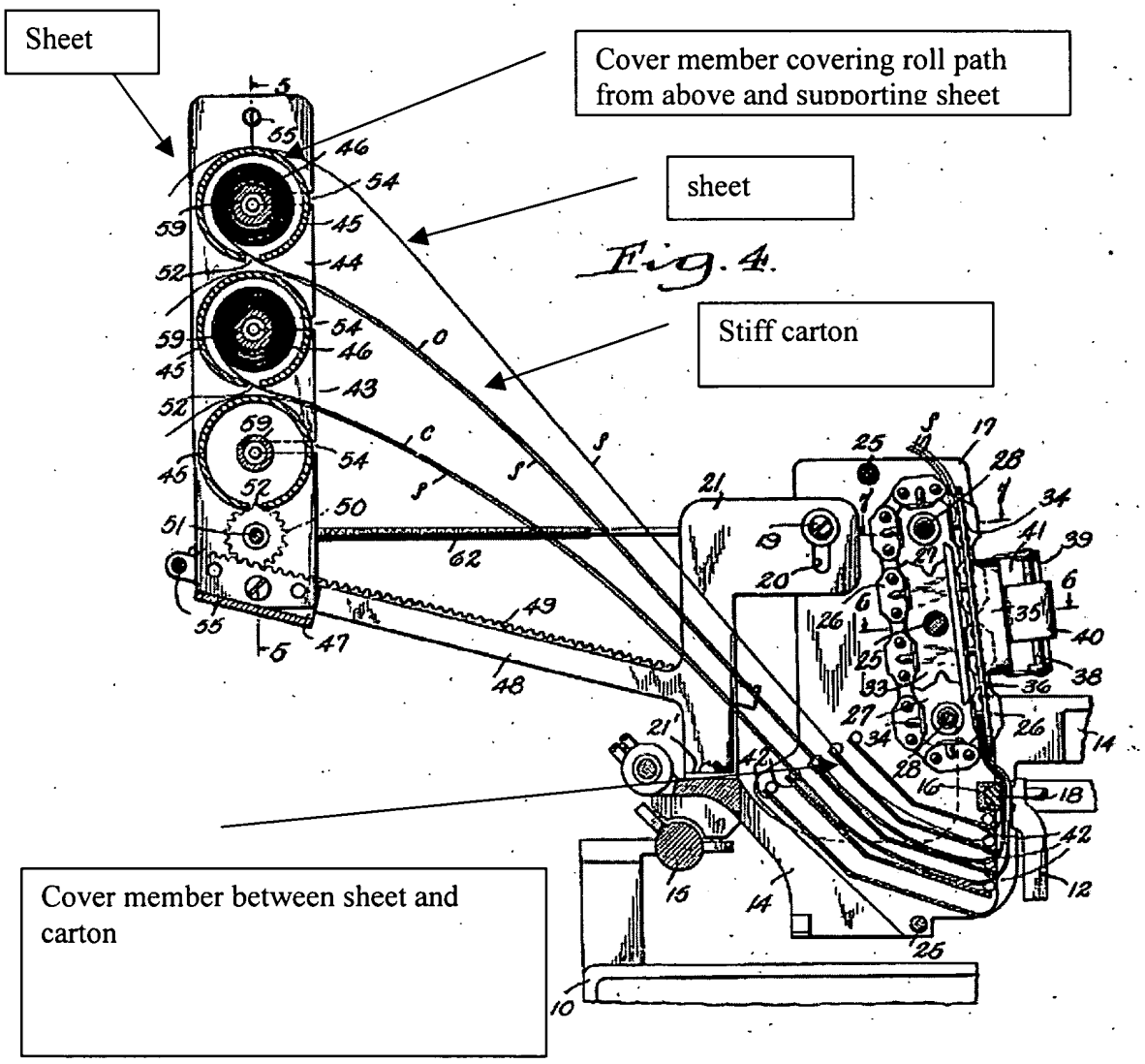
to a large printer in the appellant's claims. The examiner disagrees. A typewriter prints information. Thus, it is a printer. It is larger than a pencil – another kind of printer. Thus, it is large. Therefore, a typewriter is a large printer. The rejection under 35 USC § 103 is proper.

The appellant states that Smedal does not disclose a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level as required by the claims. Although the examiner does not know what this element means, the examiner disagrees. The claim merely requires the *possibility* (can) that a user, who is approximately 170 cm tall, be able to set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. Smedal does not disclose anything that would prevent a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level. Additionally, it appears that the appellant is not certain that Smedal does not disclose the limitation. As stated by the appellant, "a user would *almost* certainly have to bend substantially at the waist to set up the printing medium" (emphasis added). Smedal discloses a sheet feeding area as required by the claims.

Hageman in view of Metzner

The appellant states that the combination of Hageman and Metzner does not render claim 15 obvious. The examiner disagrees with the appellant. As an overview, the examiner notes that Hageman discloses an upstream cover member (45) that encircles a roll of paper (thus covering it

from above) and supports a sheet of paper from below, and a downstream linear cover member (42). See Figure 4 as reproduced below:



The examiner's position is that if the upstream cover member (45) and the downstream cover member (42) were connected and continuous, Hageman would disclose all the limitations of the claim. Metzner discloses a device that is similar to Hageman. Metzner discloses a single continuous cover member between a printing area (15) and a stock paper storage location (26). Metzner teaches using a continuous cover member between a storage location and a printing area for the purpose of supporting the paper continuously between the storage location and the printing area. If one of ordinary skill in the art were to apply this teaching to Hageman, one would extend the downstream cover member (42) in the upstream direction and connect it to the upstream cover member (45) forming one continuous cover member. The combination of Hageman and Metzner renders claim 15 obvious.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Patrick Mackey

Conferees:

Richard Ridley
Gene Crawford
Patrick Mackey